

2882

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re: Appln. Of: YAMAMOTO
Serial No.: 09/890,143
Filed: July 26, 2001
For: OPTICAL ELEMENT SUCH AS MULTILAYER FILM...
Group: 2882
Examiner: PAMELA R. HOBDEN
DOCKET: SHIG 19990241

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The Assistant Commissioner of Patents
Washington, D.C. 20231

AMENDMENT A

Dear Sir:

In response to the election requirement mailed September 20, 2002, Applicant elects claim Group I, and claims 1, and 3-27, which are believed readable thereon.

The restriction requirement is respectfully traversed.

In requiring restriction, the Examiner states "the optical fiber can be made by another materially different process such as dissolving layers by a chemical process." Applicant submits that dissolving layers by a chemical process, i.e., chemical milling, is a "cutting" process. Accordingly, it is submitted the Examiner's basis for requiring restriction is in error, since the allegedly "materially different process" in fact is a cutting process.

In requiring restriction, the Examiner also notes the inventions are classified in different classes and sub-classes, thus alluding to the fact that the inventions would involve divergent fields of search. However, as the Examiner is well aware, such a factor per se is not a basis for determining distinctiveness in accordance with MPEP 806.

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Furthermore, it is respectfully submitted that there is nothing in 35 USC § 121 that gives the Patent Office the authority to require restriction between different statutory classes of claims unless the claims cover "independent and distinct inventions." It is respectfully submitted that the statutory requirements not having been met here vis-a-vis Groups I and II respectively, the Examiner should withdraw the requirement for restriction and provide Applicant with an action on the merits of the withdrawn claims.

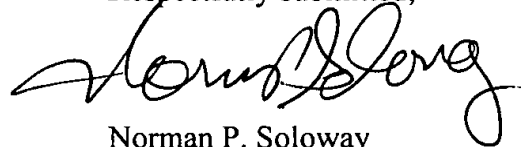
It should be noted that restriction requirements as prescribed by 35 USC § 121 are discretionary with the Examiner, and in view of the remarks above, the restriction requirement should be withdrawn.

In summary, therefore, all of the claims are believed to be directed to a single invention. However, so as to be fully responsive, Applicant provisionally elects to prosecute Group I, i.e., claims 1 and 3-27¹, and it is requested that, without further action thereon, the remaining claims be retained in this Application pending disposition of the Application, and for possible filing of a divisional application.

An action on the merits is respectfully requested.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our deposit account number 08-1391.

Respectfully submitted,



Norman P. Soloway
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Reg. No. 24,315

¹ The Office Action Summary, Form PTO-326, lists claims 1-19 as pending; however, as noted in the Detailed Action, the Application comprises 27 claims.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. 20231 on October 7, 2002, at Tucson, Arizona.

By Riyat Mishalane

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